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Crowell & Moring LLP Intellectual Property Group P. O. Box 14300 Washington, DC 20044-4300			ESTREMSKY, GARY WAYNE	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20040407

Application Number: 09/835,063

Filing Date: April 16, 2001

Appellant(s): RASS ET AL.

Gary Edwards Reg. No. 31,824
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 12, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement indicating that there are no related appeals or interferences which will directly affect, or be directly affected by, or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

This appeal involves claims 1-5 and 7.

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment after Final filed February 10, 2004 has been entered.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that for purpose of this Appeal, claims 1-5 and 7 do stand or fall together.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

2,629,621	ROETHEL	2-1953	
2,210,989	SUTHERLAND	8-1940	
2,244,951	JOYCE	6-1941	
2,893,774	CARPENTER	7-1959	
5,064,299	HAMADA	11-1991	
United Kingdom Pat. Document	673 225	Hallam	Date 6-1952
European Pat. Document	0 314 075	Galantucci	Date 5-1989
Germany Pat. Document	196 49 743	Meyer	Date 56-1997
France Pat. Document	2 633 654	Mastrazzo	Date 1-1990

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 314 075 B1 in view of U.S. Pat. No. 2,629,621 to Roethel.

EP '075 teaches Applicant's claim limitations including : "latching housing" - including 4, a "rotary latch" - 3, "mounted in the lock housing" - 10, "tapers trapezoidally" - as shown in Fig 1, "spring biased sliding wedges" - 26,26.

The reference teaches tongue and groove structure between the wedges and the housing but does not disclose "rough positioning guide elements" comprising "bore" and "guide rod" structure and "fine-positioning guide elements" comprising "side walls of the housing" and "planar side surfaces of the latching wedges". However, Roethel '621 teaches a similar device with wedge having a bore and a corresponding guide rod, the wedges and housing also having adjacent planar sides for guiding sliding movement of the wedges within the housing.

It would have been an obvious design choice or engineering expedient for one of ordinary skill in the art at the time of the invention to provide the sliding wedges of EP '075 with bores/guide rods and corresponding planar guide surfaces on the wedge and housing elements as taught by Roethel '621 for the reasons noted by Roethel '621 (col 3, line 43-53 for example). Applicant's written description discloses "diametrical guide play of approximately 0.2 mm, for example, is advantageous" at page 6; line 6. While the claim does not specify any particular amount of tolerance, one of ordinary skill in the art would recognize that at least a small amount of tolerance is unavoidable , and

desirable to achieve smooth sliding. Regardless, The Roethel '621 illustrates the rod/bore structure to include substantial tolerance in the vicinity of the spring as shown in Fig 's 2 and 3 for example.

One of ordinary skill in the art would recognize the sliding guide structures of Roethel '621 and EP '075 as mechanical equivalents since both structures are mechanically similar and perform the same function of guiding the respective wedge for sliding motion, the choice of either depending on desired manufacturing techniques or other design considerations not affecting function. One of ordinary skill in the art would have more than a reasonable expectation of success since both structures are well known in the art of latches (but more particularly in the art of automotive latches specifically adapted for guiding latch/striker into alignment during closing), and since the choice of either would not otherwise affect function of the disclosed device.

As regards claim 2, EP '075 illustrates structure rigidly connecting the sidewalls of the housing, which reads on "base plate".

As regards claim 5, part 5 is attached at both ends to plates thereby forming a "U-shaped latching bracket with the ends of the U limbs fastened to a baseplate".

(11) Response to Argument

2. Applicant's arguments have been fully considered but they are not persuasive.

As regards the Roethel '621 reference, as shown in Fig 2, the latch moves right to left during closing movement, the curved portion below the latch contacting the

wedge during closing movement and inherently pushing it down and to the left to reach the final, tightly-closed position illustrated in that Fig 2.

At least the small amount of tolerance or 'play' that would be inherent to manufacture and successful function of sliding rod/bore structures is well illustrated/disclosed in the prior art. The actual amount of tolerance disclosed in correspondence with present claim limitation would generally be considered a small amount. Regardless, Figures 2 and 3 for example of Roethel '621, as relied upon for the proposed modification, explicitly disclose substantial tolerance between the guide rod and bore, even taking into account presence of the spring (64). That tolerance inherently teaches "guide play".

Roethel '621, as relied upon, teaches planar surfaces on corresponding slidable guide surfaces of the housing and wedge element. Despite the inherent play provided by the substantial gap between the guide rod and bore, the corresponding planar surfaces of the wedge and housing of Roethel '621, as relied upon, inherently provide "fine lateral positional fixing" of the wedge relative to the housing since the wedge will be forced towards the housing sides and there fixed in the final closed position. Since guide rods and bores (as taught by Roethel '621) are substituted for the tongue and groove guide structures of the EP '075 reference, one of ordinary skill in the art would most naturally include the balance of the guide structure of the reference as well. Accordingly, all structure of the claimed invention is taught by EP '075 as modified in view of the teachings of Roethel '621.

While the latch of EP 075, as modified in view of the teachings of Roethel '621 teaches all of the claimed structure and inherently functions as recited in the claim, the examiner notes that ultimately, a *product* claim must rely upon the structure defined in the claim for patentability. While structure may be further defined by functional recitations, often such limitations are broad where particular structure is not further defined. See MPEP 2114. The present claim is not considered to be a *product* and *process of using* in the same claim. See MPEP 2173.05(p) section II.

As well settled in case law, it is the claims which define the scope of protection and therefore the invention. It is the examiner's position that the *product* claims of the Application for which Applicant now seeks exclusive rights to, have not patentably distinguished from well known structure of the prior art products from the same field of endeavor.

It's noted that limitations for rough and fine positioning guide elements should not be given weight in accordance with 35 USC 112, 6th paragraph. See MPEP 2181-2185. Applicant's arguments hinge on a functional capability of the elements within context of some intended use. However, the claims do not define any structure that is not taught by the references, as applied. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural

limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987) The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

The structural similarity of the prior art structure with the presently *disclosed* structure should be noted. Specifically, Figure 1 of present disclosure (particularly the rod/bore structure) of the present Application is referenced for comparison with Fig 2 of the Roethel '621 prior art reference, as that structure has been relied upon in grounds of rejection. The prior art teaches all structures explicitly claimed and those structures of the prior art are inherently capable of the recited function given their geometry and arrangement.

Applicant argues that the Roethel patent has no 'explicit discussion' of "guide play" but does not fully address explicit illustration of tolerance or 'guide play' in Fig's 2-4 of the reference for example. One of ordinary skill in the art would readily recognize that the illustrated tolerance unavoidably and inherently provides for some amount of movement or 'play'. Further functional recitation related to the guide play has not patentably distinguished from the structure of the reference which is inherently capable of same. Present disclosure indicates that the inventive tolerance or 'play' is very small

(“.2 mm, for example”) but the claims have not described a range of tolerance that can be relied upon for patentable distinction from the expected tolerance inherent to manufacturing of the prior art structure as required for achieving its intended sliding movement, or otherwise distinct from the generous amount of tolerance explicitly illustrated in the Figures. Comparison of spring/rod/bore in Fig 3 of Roethel '621 with corresponding structure shown in Fig 1 of present disclosure is suggested.

While there may or may not be structural differences between Applicant's *disclosed* invention and the prior art, since the present *product* claims have not defined any particular structure or range of tolerance between structures that can be relied upon for patentable distinction from the similar and well known prior art products, withdrawal of present grounds of rejection is not proper.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Primary Examiner
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April 7, 2004

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